REMARKS

1.   Applicant thanks the Examiner for his remarks and observations.

5   2.   It should be appreciated that Applicant has elected to amend Claim 7 and cancel Claims 50-51 solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals, 65 Fed. Reg. 54603 (9/8/00). In making such amendments, Applicant has not and does not in any way narrow the scope of protection to which

10   Applicant considers the invention herein to be entitled. Rather, Applicant reserves Applicant's right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

15   3.   Claims 1 – 51 stand provisionally rejected based on the judicially-created doctrine of obviousness-type double-patenting as being unpatentable over claims 1 – 12, and 14-40 of U.S. Patent Application Ser. No. 09/328,737. The Examiner bases the current rejection on "applicant's own admission the current application and the '737 application claim a single software package

20   having a trial and a purchase version." However, the mere fact that the claims of each application share a small number of common elements does not establish a *prima facie* case of obviousness. Beyond noting Applicant's acknowledgment that the independent claims share a small number of common elements, the Examiner makes no attempt at a showing that the

25   claims in the current application are obvious in view of the claims of the parent. Accordingly, the current rejection is deemed improper. In spite of this, Applicant submits herewith a terminal disclaimer in the current application. Such submission is done only to expedite prosecution of the Application and is not to be taken as Applicant's agreement with the

30   Examiner's finding. Thus, the obviousness-type double-patenting rejection is deemed to be overcome.

4.   The Examiner relies on *Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc.*, 726 F.3d 724 (Fed. Cir. 1984) for the proposition that

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additional references may be applied to interpret an allegedly anticipating reference. Although *Studiengesellschaft Kohle* makes brief mention of the rule permitting the use of additional references, *Studiengesellschaft Kohle's* particular relevance here is due to another principle of law elucidated therein,

5 that it is impermissible to combine the teachings of references to build a finding of anticipation.

In *Studiengesellschaft Kohle*, the Appellant argued that the allegedly anticipating reference combined with two additional references that

10 demonstrated the knowledge available to one of ordinary skill in the art showed that a specific mixture of chemical compounds would form under certain conditions. Reasoning that the appellant was relying on the references for a very specific teaching, and not for any light that they would shed upon what the inventor would have meant to those skilled in the art, the

15 court found that the Appellant was asking the court to combine the teachings of the references to build an anticipation.

In this case, the allegedly anticipating reference, Hurley, contains a comment that "[t]he use of such access codes for unlocking products or features

20 purchased is conventional." Additionally, Hurley specifically mentions the references Hellman, Chou, and Chernow in the description of the prior art. The comment with respect to the references is of similar scope to the first comment.

25 Accordingly, the Examiner's use of extrinsic evidence is limited to explaining what one having ordinary skill would have understood Hurley to mean by this statement. As in *Studiengesellschaft Kohle*, use of the references to supply missing claim limitations is improper.

30 As described in greater detail below, the Examiner relies on the combination of Hellman, Chou, and Chernow as teaching:

"A <u>software package comprising</u>:

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a first object, said first object a full-featured version of at least one software product, wherein said user is denied access to said first object;

a second object, said second object a further version of said software product having some, but less than all, of the features of said first object;

an access and control portion, said access and control portion affording selective access to any of said first and second objects, wherein said access and control portion includes usage authorization information; and

a notifier . . . ."

The Examiner has pointed to no teaching in Hurley that describes the above features of the Claimed invention. Because Hurley lacks any teaching or suggestion of such elements, any attempt by the Examiner to find a teaching or suggestion of such elements in the additional references, under cover of interpreting Hurley, goes beyond interpreting what the person having ordinary skill would understand by Hurley's statement. Thus, the Examiner relies on the combination not to interpret Hurley, but to supply missing claim limitations, which is impermissible, according to the Examiner's own legal precedent. Furthermore, the fact that the Examiner, using claim 1 of the current application as a template, had to resort to cherry-picking a combination of three references plus Hurley to build a § 102(e) rejection of claim 1 is highly persuasive evidence that there is no single reference that teaches all elements of claim 1, a necessity for anticipation.

5.   Applicant provides herein below some comments on the Examiner's rebuttal of Applicant's previous arguments, in view of the Examiner's new reliance on *Studiengesellschaft Kohle*.

A.   Regarding Item 5:   The Examiner finds Applicant's argument that Hurley does not teach selective access to the software depending on whether or not they have made a purchase is not persuasive. The Examiner misstates Applicant's argument. Applicant stated, "Thus, Hurley does teach that the

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user is given selective access to the software, depending on whether or not they have made a purchase, and what features or products they have purchased." Applicant did state, "However, Hurley is silent as to how the selective access is to be provided, merely saying that products or features are

5   unlocked using the access code. There is no anticipation of first and second objects because Hurley doesn't teach first and second objects."

Chou describes at Col. 1, line 56 to Col. 2, line 3:

10   In carrying out this invention in one illustrative embodiment thereof, a method of protecting distributed encrypted software of a distributor from unauthorized use of a user comprises the steps of utilizing a unique factor, e.g., a file which constitutes a fingerprint of the computer of the user, or a key constituting an integral computer part, or a random factor, e.g., time of entry, utilizing the

15   unique factor or random factor or a combination thereof in the user's computer, generating a first key based on said use, sending said first key to a processing center, generating a second key from said processing center to the user, applying the second key to the user's computer in which said entry is checked and using the second key with said first key in an algorithm to

20   provide a key for decrypting the distributed software."

Thus, Chou accomplishes its object of "to provide protection in software program distribution for programs which are distributed and are then limited in use to those who request and pay for the privilege of using the program

25   without employing additional external hardware." Col 3, line 45 to line 50. However, even if the Examiner's reliance on Chou is proper there is no teaching in Chou or in Hurley of how to provide selective access to first and second objects. The cited teaching at Col. 3, line 12 to Col 4, line 3 of Chou adds nothing to this. The teaching does describe providing access to the

30   encrypted object or objects provided in Chou's software package, but there is no teaching whatsoever that would enable one having an ordinary level of skill in the art to provide selective access to first and second objects as described by the claimed invention.

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B.   Regarding Item 6:   The Examiner finds Applicant's arguments regarding the notifier of Claim 1 unpersuasive. As discussed above, the Examiner's reliance on Chernow to supply the teaching of a notifier is improper. Applicant also notes that the remarks regarding Chernow refer to language nowhere found in the claims. Applicant strenuously objects to the inclusion of irrelevant subject matter that appears to have come from another file. Even if the Examiner's reliance on Chernow were proper, there is no teaching or suggestion of a notifier that is part of a software package. Chernow describes, "[t]he Interactive Program is located on the Central Computer (seller's computer) and provides all of the functions necessary to complete a transaction with a customer." Col. 5, line 55 to line 58. Thus, Chernow's interactive program is not part of a software package acquired by the u ser, but i s r ather a c omponent of a s ales a nd distribution s ystem that operates from the seller's computer.   There is therefore no teaching or suggestion in either Chernow or Hurley of a notifier included in a software package.

C.   Regarding Item 7:   The Examiner finds Applicant's arguments regarding the access and control portion of claims 1 and 6 containing usage authorization information unpersuasive. The operation of Chou's unencrypted installation utility is described at Col. 3, line 26 to Col. 4, line 3. The operation of the installation utility is also depicted in the single drawing in the reference. The o nly c omponent of C hou's s ystem t hat m ight p roperly b e c alled u sage authorization information is the K_2 issued by the processing center upon the user providing the K_1, which was generated by the installation utility from the unique computer profile, which was itself created by the installation utility. Thus, there is no teaching or suggestion in Chou of an access and control portion that includes usage authorization information.

D.   Regarding Item 8: The Examiner finds Applicant's argument that there is no teaching of first object, second object, and usage information being macro-compressed or micro-compressed unpersuasive.   As previously established, there is no teaching or suggestion in Chou of first and second objects, nor is there any teaching of usage authorization information being

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included in the access and control portion. The Examiner himself notes that Chou teaches that "software packages can be <u>encrypted</u> . . . ." It is exceedingly well known to those having ordinary skill in the art that compression and encryption are two different processes having entirely

5   different mechanisms, purposes and effects. Accordingly, teaching that a software package is encrypted is decidedly not a teaching that a software package is macro-compressed or micro-compressed.

E.   Regarding Item 9:   The Examiner finds Applicant's argument that

10   Hurley does not disclose requiring users to confirm agreement with a vendor on a user license unpersuasive.   As above, the Examiner's reliance on Chernow to teach missing claim limitations is improper.   Furthermore, Chernow does not teach that confirming the agreement with the vendor is accomplished by way of a notifier that is provided as part of a software

15   package.

F.   The Examiner finds Applicant's argument that Hurley does not teach selecting one or more use o ptions . . .<u>wherein the use options are objects</u> available free of charge or those purchased by the user . . wherein <u>one or</u>

20   <u>more of said objects</u> are <u>retrieved by said executable code section</u> . . .unpersuasive. Applicant respectfully disagrees.   Hurley teaches selecting from two levels of functionality in a <u>single object</u>. It has been previously established that Hurley <u>does not describe a notifier included as part of a</u> <u>software package,</u> nor does Hurley describe a <u>notifier that includes an</u>

25   <u>executable code section</u>.

H.   The E xaminer finds A pplicant's argument t hat H urley d oes not t each inserting transaction information in said software product as a watermark unpersuasive.   Applicant respectfully disagrees.   There is no teaching in

30   Hurley of inserting transaction information in a software product as a watermark.   At Col. 4, line 64-66 Hurley describes how <u>the access code</u> includes information on which products and features to unlock, and other information to insure validity.   However, the access code <u>is not the software,</u> <u>nor is it part of a software package</u>. As shown in Figs. 2 and 3 of Hurley, the

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access code is a separate object from the software package. Under cover of interpreting Hurley, the Examiner relies on Hellman as teaching a watermark. Even if the Examiner's reliance on Hellman were proper, Hellman would add nothing to Hurley. Col. 5, lines 57-65 of Hellman describe the transmittal of a

5 software order from a base unit to an authorization and billing unit. Col. 6, line 5 to line 8 describes the authorization and billing unit returning an authorization to the base unit. There is no teaching whatsoever that the order information is somehow inserted into the software. Furthermore, even if the validation information were somehow inserted into the software, the Examiner

10 finds that it would be considered a watermark because its validity could be determined visually. Applicant intends the Examiner no respect, but his reasoning here is opaque. What is more, conjecture or speculation as to what a reference could contain is not a proper basis for a finding of anticipation.

15 I. The Examiner misstates Applicant's argument concerning Drake. Applicant's argument was that Drake does not protect against dump attacks. Drake serves only a monitoring function, and the only remedy Drake provides against a dump attack is to interrupt it by terminating the program being attacked, or to intercept program ID data and invalidate it. Drake provides no

20 capability of preventing dump attacks and/or class attacks. Hurley contains no teaching whatsoever related to protection against attack.

6. Claims 1-23, 25-28 and 28-40 stand rejected under 35 U.S.C. § 102(e)

25 as being anticipated by U.S. Patent No. 5,984,508 ("Hurley"). Applicant respectfully disagrees. For a reference to anticipate a Claim, the reference must describe each and every element of the Claim; the identical invention must be shown in as complete detail as contained in the Claim; and the elements must be arranged as required in the Claim. MPEP § 2131.01. While

30 the Examiner relies on Studiengesellschaft Kohle as authority to use Hellman, Chernow and Chou to interpret the Hurley teachings, as described above, the additional references add nothing to Hurley.

A. Regarding Claim 1: Claim 1 of the application describes:

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A method of evaluating software by a user for subsequent purchase comprising the steps of:

acquiring a software package, said software package

5   comprising:

a first object, said first object a full-featured version of at least one software product, wherein said user is denied access to said first .object;

a second object, said second object a further version of said

10 software product having some, but less than all, of the features of said first object;

an access and control portion, said access and control portion affording selective access to any of said first and second objects, wherein said access and control portion includes usage authorization

15 information; and

a notifier;

installing said software package on said buyer's computer system;

accessing said second object, access to said second object being unrestricted; and

20 evaluating said second object whereby said user assesses whether said software product meets said user's requirements.

The Examiner is unable to point to any portion of Hurley that teaches first and second objects, wherein the first object is a full-featured version of a software

25 product, wherein said user is denied access to said first object; and wherein the second object is further version of the software product having some, but less than all, of the features of the first object. Hurley teaches "Software allows a vendor to grant full access to demonstration software that has been downloaded to a user's computer . . . "(Abstract, line 1 to line 2); and "An

30 access code . . . includes information on which products and features to unlock . . ." (Col. 4, line 62 to line 65.) Thus, Hurley does teach that the user is given selective access to the software, depending on whether or not they have made a purchase, and what features or products they have purchased. However, Hurley is silent as to how the selective access is to be provided,

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merely saying that products or features are unlocked using the access code. There is no anticipation of <u>first and second objects</u> because Hurley doesn't teach <u>first and second objects</u>.

5   The Examiner finds that Hurley's cursory mention of unlocking software in line 1 of the Abstract describes <u>an access and control portion, said access and control portion affording selective access to any of said first and second objects</u>. Beyond this mention, there is no description of the "lock" that the Examiner maintains that Hurley describes. Thus, a passing reference to
10   unlocking software does not describe <u>an access and control portion affording selective access to any of said first and second objects</u>; now would it place the invention in the possession of a person of ordinary skill or enable them to make or use the invention, both additional requirements for anticipation. The Examiner is unable to point to anything in Hurley that describes "<u>wherein said
15   access and control portion includes usage authorization information</u>."

The only other element in Hurley that has anything to do with access and control is Hurley's access module 128. However, it is clear from the Abstract,
20   line 1, Figure 1 and Col. 4, line 27 that the access module is completely independent of the software. Thus, there is no teaching in Hurley of "an access and control portion" <u>included in a software package</u>. While Chou teaches an access and control portion, there is no teaching in Chou of <u>wherein said access and control portion includes usage authorization
25   information</u>, even if reliance on Chou were proper.

The Examiner finds that a "serial number generated on the user's system" and provided to the vendor at time of purchase (Col. 4, line 51 to 54) describes <u>a notifier</u>. However, the serial number, generated on the user's computer at
30   some point after the demo software is saved to the user's computer, constitutes information supplied <u>to the vendor</u> from the user's computer. It has nothing to do with providing information to the user by the vendor. In stark contrast, the Claimed Invention includes a <u>notifier</u> in the software package. One skilled in the art would readily recognize that a notifier

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provided by the vendor to the user would convey information from the vendor to the user, and not vice versa.

Accordingly, the rejection of Claim 1 under 35 U.S.C. § 102(e) is deemed to
5   be improper.

B.   Regarding Claim 6: There is no teaching in Hurley of "wherein said first object and said usage authorization information are encrypted, whereby said user is prevented from accessing and using said first object and said
10   usage authorization information until said prospective user executes a purchase request, thereby acquiring a license to at least some of the rights to said software product" because, as above, there is no teaching in Hurley of a first object and usage authorization information. Accordingly, the rejection of Claim 6 under 35 U.S.C. § 102(e) is deemed to be improper. As above, even
15   if reliance on Chou were proper, Chou contains no teaching of first and second objects and usage authorization information being included in a software package.

C.   Regarding Claim 7: There is no teaching in Hurley of: wherein said first
20   object, said second object and said usage authorization information are macro-compressed and optionally, micro-compressed. Even if reliance on Chou were proper, Chou contains no such teaching. Accordingly, the rejection of Claim 7 under 35 U.S.C. § 102(e) is deemed to be improper.

25   D.   Regarding Claim 16: There is no teaching in Hurley of: wherein said notifier comprises:
            an executable code section; and
            information required by said user for purchasing rights to said software product and enabling entry of transaction information required for said
30   purchase of said rights. Even if reliance in Chernow were proper, there is no teaching in Chernow of a notifier that is provided as part of a software package. Accordingly, the rejection of Claim 16 under 35 U.S.C. § 102(e) is deemed to be improper.

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E.   Regarding Claim 17: There is no teaching in Hurley of: <u>running a setup</u> <u>routine, wherein said executable code section performs normal setup</u> <u>functions, including displaying a user license; and</u>

        <u>agreeing to terms of said user license</u>. Even if reliance on Chou,
5   Chernow and Hellman were proper, they add nothing here. Accordingly, the
    rejection of Claim 17 under 35 U.S.C. § 102(e) is deemed to be improper.

F.   Regarding Claim 18: There is no teaching in Hurley of:<u> selecting one</u>
10 <u>or more use options from a listing of said use options available, said available</u>
    <u>options being those objects available free of charge or those previously</u>
    <u>purchased by said user, said listing being provided by said executable code</u>
    <u>section accessing said usage authorization information, and wherein one or</u>
    <u>more of said available objects are retrieved by said executable code section</u>
15 <u>and loaded into memory; and</u>

        <u>executing said requested use</u>.   Accordingly, the rejection of Claim 18
    under 35 U.S.C. § 102(e) is deemed to be improper. As above, there is no
    such teaching in Hurley.

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G.   Regarding Claims 48-49. The Examiner is unable to point to anything
    in Hurley that teaches: <u>wherein said server inserts transaction information in</u>
    <u>said software product as a watermark</u>. Accordingly, the rejection of Claims 48
    and 49 under 35 U.S.C. § 102(e) is deemed to be improper. As above, even
25 if reliance on Hellman were proper, Hellman adds nothing here.

H.   Regarding Claims 50-51. The Examiner finds that Col. 4, line 64 to line
    66 of Hurley, that the access code contains other information to ensure its
    validity, anticipates <u>wherein said server inserts transaction information in said</u>
30 <u>access control code as a watermark</u>. While watermarking may possibly be a
    way of ensuring validity, it its well-established that a genus does not anticipate
    a species. Here, the Examiner finds that a broad recital of "information to
    ensure validity" anticipates watermarking of the access code. Moreover,
    Hurley's teaching does not describe that feature at the same level of detail as

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Claims 50 and 51. Additionally, Hurley's teaching would not put one having an ordinary level of skill in possession of the invention, nor would it enable the skilled practitioner to make or use the invention. Accordingly, there is no anticipation. The rejection of the rejection of Claims 48 and 49 under 35
5 U.S.C. § 102(e) is therefore deemed to be improper. Even if reliance on Hellman were proper, as above, Hellman adds nothing here.

7.   Claims 24-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hurley in view of U.S. Patent No. 5,598,470 ("Cooper"). In
10 view of the above, there being no anticipation of Claim 1 by Hurley, the current rejection is deemed improper.

8.   Claims 45-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hurley in view of U.S. Patent No. 6,006,328 ("Drake"). In
15 view of the above, there being no anticipation of Claim 1 by Hurley, the current rejection is deemed improper. Even if the Hurley did anticipate the Claimed invention, the references, either separately or in combination would not teach all features of Claims 46 and 47. Regarding Claims 46 and 47, wherein said protection against dump attacks comprises any of erasing and
20 modifying one or more of said objects' relocation information, directory pointers, or entry point after said objects have been written into memory and wherein said protection against dump attacks comprises modifying references to external routines in an import table of said objects whereby said notifier controls access to said routines, prevents dump attacks by deliberately
25 making the very changes to the software operating environment that Drake is supposed to monitor. Drake serves only a monitoring function, and the only remedy Drake provides against a dump attack is to interrupt it by terminating the program being attacked, or to intercept program ID data and invalidate it. Drake provides no capability of preventing dump attacks and/or class attacks.
30 Hurley contains no teaching whatsoever related to protection against attack. Accordingly, the rejection of Claims 45 – 49 under 35 U.S.C. § 103(a) is deemed to be improper.

9.   Claims 50-51 are cancelled from the application.

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10.   Claim 7 is amended to correct its dependency and to eliminate the optionality of the micro-compression step.

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CONCLUSION

In view of the above, the application is deemed to be in allowable condition. Therefore, the Examiner is earnestly requested to withdraw all rejections and
10   allow the application to pass to issue as a U. S. Patent. Should the Examiner have any questions related to the application, he is urged to contact applicant's attorney at (650) 474-8400.

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Respectfully submitted,

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